

### **REMARKS**

Claims 4, 7-12, 22-24, and 26-38 are currently pending. Claims 13-20 were previously withdrawn. Claims 1-3, 5-6, 21, and 25 were previously cancelled. Claim 28 is currently amended.

Applicant wishes to thank the Examiner for the opportunity to discuss this application in a telephone interview on August 17, 2007. Reconsideration of claims 4, 7-12, 22-24, and 26-38 is respectfully requested in light of the above amendments and the following remarks.

#### **Double Patenting Rejection, Claims 1, 11, 12, 21, and 23**

Claims 1, 11, 12, 21, and 23 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 22-24 of copending Application Number 10/799,835 ("the '835 Application"). This rejection is respectfully traversed.

According to MPEP section 804 entitled "Definition of Double Patenting":

The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusively beyond the term of a patent. The policy behind this doctrine is that:

The public should. . . be able to act on the assumption that upon the expiration of the patent it will be free to use not only the invention claimed in the patent but also modifications or variants which would have been obvious to those of ordinary skill in the art at the time the invention was made, taking into account the skill in the art and prior art other than the invention claimed in the issued patent.

*In re Zickendraht*, 319 F.2d 225, 232, 138 USPQ 22, 27 (CCPA 1963) (Rich, J., concurring). Double patenting results when the right to exclude granted by a first patent is unjustly extended by the grant of a later issued patent or patents. *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982).

Applicants respectfully submit that the copending '835 Application was filed on March 12, 2004, which is the same filing date as the application presently under consideration. Since both applications were filed on the same date, no unjustified extension of patent will result. Therefore, the policy behind the doctrine of double patenting will not be served by a double patenting rejection.

Furthermore, this rejection is respectfully traversed based a fundamental defect which is discussed below.

The defect is that, as to the claims of the present application, the double patenting rejection vaguely asserts that claims 1, 11, 12, 21, and 23 recite effectively the same invention as several of the claims of the '835 Application, but does not identify any specific correspondence. A proper double patenting rejection must set forth a one-to-one correspondence between a pending claim of the present application and a respective one of the claims of the '835 Application. For example, MPEP §804 explains,

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is anticipated by, or would have been an obvious variation of the invention in a claim in the patent.

The present Office Action does not meet these requirements. In particular, as to each of Claims 1, 11, 12, 21, and 23, the present Office Action fails to identify a specific corresponding claim in the '835 Application (i.e. "a claim in the patent compared to a claim in the application"), much less set forth the "differences between the inventions defined by the conflicting claims," still less set forth any "reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent." For example, the rejection would need to establish that Claim A of the present application is obvious from patent Claim X, Claim B of the application is obvious from patent Claim Y, Claim C of the application is obvious from patent Claim Z, and so forth. The Office Action fails to do any of this. For at least this additional reason, it is respectfully submitted that the double patenting rejection should be withdrawn.

Accordingly, Applicants respectfully request the withdrawal of the nonstatutory obviousness-type double patenting rejection to claims 1, 11, 12, 21, and 23.

**Rejections under 35 U.S.C. §102(b), Claims 4, 10-12, 24, and 26-38**

Claims 4, 10-12, 24, and 26-38 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 6,206,828 to Wright ("Wright" or "the Wright patent"). This rejection is respectfully traversed.

MPEP §2131 requires, “[t]o anticipate a claim, the reference must teach every element of the claim.” Wright does not teach each and every element of independent claims 24, 28 and 34.

The Office Action of June 14, 2007 makes no attempt to identify the structures of the Wright patent that may correspond to the elements of independent claims 24 and 34. Specifically, as to claim 24, the Office Action does not identify and the Wright patent does not disclose either, “the side wall surrounding an internal bore in communication with the elongated slot” or “an anchoring device adapted to receive a bone fastener and including a connecting projection sized to slide within the internal bore and adapted for pivotal motion within the elongated slot and through the side wall.”

As to independent claim 34, the Office Action does not identify and the Wright application does not disclose, “the first distraction arm comprises a hollow bore,” “the connection post slidable within the hollow bore,” or “a first anchoring device. . . comprising. . . a second section including a through passage adapted to receive a vertebral fastener.”

Independent claim 28, as amended, recites, “a hollow tubular shaft portion” and “the pivot mechanism is movable about the pin between a first position in which the connecting post extends into the hollow tubular shaft and a second position in which the connecting post extends out of the elongated passage.” These elements are not disclosed by the Wright patent. The “side slot 334” identified in the Office Action of June 14, 2007 in no way corresponds to “a hollow tubular shaft portion.”

Claims 4, 10-12, 26, 27, 29-33, and 35-38 depend from and further limit the independent claims. Accordingly, Applicants respectfully request the withdrawal of the rejection to claims 4, 10-12, 24, and 26-38 under 35 U.S.C. §102(b).

**Conclusion**

It is clear from all of the foregoing that claims 4, 7-12, 22-24, 26-38 are in condition for allowance. The Examiner is invited to phone the Applicant's representative at the number listed below to resolve any open issues which the Examiner has identified.

A formal notice of allowance of claims 4, 7-12, 22-24, 26-38 is requested.

Respectfully submitted,



Julie M. Nickols

Registration No. 50,826

Dated: 8/27/07

HAYNES AND BOONE, LLP  
901 Main Street, Suite 3100  
Dallas, Texas 75202-3789  
Telephone: 972/739-8640  
Facsimile: 214/200-0853  
Client Matter No.: PC1077.00  
Attorney Docket No.: 31132.237  
Document No.: R-173871

